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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/298,505 04/23/99 HOLM-BLAGG

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EXAMINER

TM02/0522

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ART UNIT

PAPER NUMBER

2167

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

CM

Office Action Summary

Application No.
09/298,505

Applicant(s)
Holm-Bragg et al

Examiner
Andrew J. Fischer

Art Unit
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 20) ☐ Other: _____

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DETAILED ACTION

Specification

1. The specification is objected to because of the missing serial numbers in the "Related Applications" section. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, and 21-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.
 - a. In claim 5, there are no additional steps. It is therefore unclear whether Applicants are claiming a method or an apparatus.
 - b. In claim 6, there are no additional steps. It is therefore unclear whether Applicants are claiming a method or an apparatus.
 - c. In claim 21, the limitation "a set of business rules" is indefinite because business rules and standards change over time.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-24, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pickering (U.S. 5,483,445). Pickering discloses a primary owner for the group (the customer); a dependent financial record corresponding to a dependent account (one of the bills); the dependent account having a dependent strategy or parameter for controlling group processing options (how much to pay, when the payment due); group master data (customer number and customers address) that is associated with the group to facilitate processing (mailing); the group master data includes a group identifier (a customer number); group control settings (a maximum limit on the dollar

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amount of all the bills); and group aggregate data (total amount customer owes for all bills); the primary owner and the dependent financial record are linked through the group master data (a customer number or any keyed field in the database); providing a key financial record (keyed customer number, a keyed field is required in all indexed databases) corresponding to a key account (the customer's account with the bill consolidating service which would add a fee for the service) and is distinct from the group master data (just another bill—but for the consolidating service); the key financial record is linked to the group master data via a predefined relationship (a one-to-one relationship); a second dependent financial record (another bill) having a second account and also having a second strategy (how much to pay, when is the payment due); the second dependent account is linked through the group master data to support overall processing (the customer's one bill from consolidator) and group processing (itemizing all charges from a particular 3rd party; the dependent account corresponds to one product (utilities) and the second dependent account corresponds to another product (a credit card); wherein the first and second dependent strategies and the first and second accounts are independent of one another (bill 1's due date is completely independent of bill 2's due date); wherein the first and second accounts are of different types of products (one could be a utility, one could be a credit card); the first authorization option specifies how a transaction directed to the first dependent account is authorized (specifically authorizes who is to be the payee); the bills are for general use cards (VISA, MASTERCARD) or private label cards (MACY'S); and account history is provided to the customer.

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7. It is the examiner's position that Pickering anticipates the claimed method because the method is inherently disclosed. The rationale for this inherency is that the prior art device, in its normal and usual operation, would necessarily perform the claimed method. See MPEP §2112.02.

However, even if not anticipated, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Pickering to include the claimed method. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be a logical step when using the disclosed structure.

8. Functional recitation(s) using the word "to" and "for" (e.g. "to support group processing" as recited in claim 1) have been given little patentable weight because they fail to add any additional steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in an additional step between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Northington et. al. (U.S. 6,128,602); Dent et. al. (U.S. 6,128,603); Kenna et. al. (U.S. 6,108,641); Watson (U.S. 5,978,780); Fleming (U.S. 5,953,710); Wynn (U.S. 5,859,419); Pickering (U.S. 5,684,965); and Kashkashian, Jr. (U.S. 4,700,055).
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.


Richard Chilcot
Supervisory Patent Examiner
Technology Center 2167


ANDREW J. FISCHER
PATENT EXAMINER

AJF
May 16, 2001